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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,974	12/21/2001	Charles R. Wescott	DYX-024.1 US	2108
26161	7590	03/12/2004	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			WAX, ROBERT A	
			ART UNIT	PAPER NUMBER
			1653	

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/034,974	Applicant(s) WESCOTT ET AL.	
	Examiner Robert A. Wax	Art Unit 1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-35 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11, 20-24 and 27-31, drawn to polypeptides, magnetic resonance imaging agents and labeled polypeptides, classified in class 530, subclass 326.
 - II. Claims 12-15, drawn to method of detecting fibrin, classified in class 424, subclass 9.1.
 - III. Claims 16-18, drawn to method of treating a disease involving thrombus formation, classified in class 514, subclass 14.
 - IV. Claim 19, drawn to recombinant host cell, classified in class 435, subclass 325.
 - V. Claims 25-26, drawn to a method of identifying fibrin binding compounds, classified in class 435, subclass 7.1.
 - VI. Claims 32-34, drawn to a method of medical imaging, classified in class 424, subclass 9.1.
 - VII. Claim 35, drawn to a method of purifying fibrin, classified in class 530, subclass 412.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II, III and V-VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1)

the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in the several materially different processes claimed.

3. The protein of Invention I and the recombinant host cell of Invention IV are related by virtue of the nucleic acid that encodes the protein and is expressed in the host cell. However, the protein itself is not necessary to express the nucleic acid in the host cell and both the protein and host cell have wholly different compositions and functions. Therefore, these inventions are distinct.

4. Inventions II, III, V, VI and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the several methods of the Groups do not require each other for their practice; have separate utilities; are physically, chemically and biologically different from each other; and are subject to separate manufacture and sale from each other. These groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

5. Inventions IV and II, III, V, VI and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have

different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the host cell of Group IV and the several methods of Groups II, III, V, VI and VII do not require each other for their practice; have separate utilities; are physically, chemically and biologically different from each other; and are subject to separate manufacture and sale from each other. These groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

6. Furthermore, in claims 1-35 the presence of multiple polypeptide sequences, each with a different SEQ ID No., allows for a variety of patentably distinct products. Depending on the sequence of each polypeptide, the characteristics of the resulting molecule will vary in regards to structure and function. Each one of these polypeptides is, for example, capable of eliciting a specific immune response and can be used to produce a specific antibody. Therefore, these polypeptides are patentably distinct absent factual evidence to the contrary. Applicants are required under 35 U.S.C. 121 to elect a single SEQ ID No. for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Examiner is willing to examine a reasonable number of polypeptides together, should applicants be able to identify subgenera comprising related polypeptides. Such a subgenus could be identified, for example, by specifying only basic amino acids at a particular position. Applicants' attorney is encouraged to discuss proposals with the Examiner prior to filing a response to this Office action.

Applicants are advised that a reply to this requirement must include an identification of SEQ ID No. that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

7. Because these inventions are distinct for the reasons given above and the searches required for each of the several Groups are different, restriction for examination purposes as indicated is proper.

8. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Wax whose telephone number is (571) 272-0623. The examiner can normally be reached on Monday through Friday, between 9:00 AM and 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. F. Low can be reached on (571) 272-0951. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Robert A. Wax', is positioned above the printed name.

Robert A. Wax
Primary Examiner
Art Unit 1653